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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER PASS, NATALIE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/892,857	KOGURE, KENJI	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008 and 28 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8,11,13,15-22,26,28,30-33 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-8, 11, 13, 15-22, 26, 28, 30-33, 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 27 May 2008 and 28 April 2008 have been entered.

2. This communication is in response to the Request for Continued Examination filed 27 May 2008 and the amendment filed on 28 April 2008. Claims 2, 4, 9-10, 12, 14, 23-25, 27, 29, 34-35 have been cancelled. Claims 1, 6-7, 11, 17-18, 26, 31-32, 36-37 have been amended. Claim 38 has been newly added. Claims 1, 3, 5-8, 11, 13, 15-22, 26, 28, 30-33, 36-38 remain pending.

Claim Objections

3. Applicant is advised, as discussed in the previous Office action (paper number 20080212), that should claims 13, 16 be found allowable, claims 15, 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. In addition, should claims 13, 16 be found allowable, claims 18, 21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one

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claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 6-7 recite “according to claim 41” in lines 1-2, respectively; however no claim 41 has been presented. For the purpose of applying art, Examiner assumes these recitations to read “according to claim 1.” Correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Newly added claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Peterson et al, U.S. Patent Number 5, 903, 873.

(A) As per newly added claim 38, Peterson teaches a method comprising inputting personal data of a first customer of a group as first registration information (Peterson; Figure 30, column 23, lines 37-47) and at least a first name of each remaining customer of the group as second registration information (Peterson; column 2, lines 35-40, column 19, lines 1-12, column 24, lines 38-45, column 25, lines 33-35, column 26, lines 42-61, column 40, line 60 to column 41, line 43);

selecting a "Customer Group Info icon" (reads on "family name button") (Peterson; Figure 5, Figure 6, Item 3.7.1) to input the personal data of the remaining customers, which is common to the personal data of the first customer, as part of the second registration information (Peterson; column 17, lines 46-58, column 19, lines 1-12, column 24, lines 38-45, column 25, lines 33-35, column 26, lines 42-61, column 40, line 60 to column 41, line 43); and

processing and executing a single collective contract or individual contracts with respect to the first customer and the remaining customers based on the first registration data and the second registration data, respectively (Peterson; column 3, line 36 to column 4, line 27, column 15, lines 8-16, column 27, lines 10-17, column 34, lines 3-11, column 38, lines 36-45).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 5-8, 11, 13, 15-22, 26, 28, 30-33, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al, U.S. Patent Number 6, 959, 298 for substantially the same reasons given in the previous Office Action (paper number 20080212), and further in view of Peterson et al, U.S. Patent Number 5, 903, 873. Further reasons appear hereinbelow.

(A) Claim 11 has been amended to include the recitation of

- ♦ "[...] selecting a family name button when a family name of the remaining customers is a same as that of the representative customer [...]," at lines 15-16; and
- ♦ "[...] wherein the inputting a family name of the representative customer, as the personal data of the remaining customers, upon selection of said family name button [...]," at lines 17-18.

As per newly amended claim 11, Silverbrook teaches an automated contract engaging method in which a group of customers being a first party and having common personal data except at least name engages a single collective contract or a plurality of individual contracts with a second party on an automated contract engaging apparatus including a display, said method comprising:

inputting the personal data of a representative customer of the group as first registration data (Silverbrook; Figure 21, column 47, lines 27-28);

inputting at least the name of each of the remaining customers of the group as second registration data (Silverbrook; Figure 51, Figure 81, Figure 82, Figure 84, column 48, line 1);

processing and executing the single collective contract or the individual contracts with respect to the plural customers based on said first registration data input in the inputting the personal data step and said second registration data input in the inputting at least the name step (Silverbrook; Figure 51, Figure 82, Figure 84, column 47, line 61 to column 48, line 2, column 50, lines 50-54); and

inputting the common personal data of the remaining customers of the group using part of said first registration data which part is common to the group (Silverbrook; Figure 63, Figure 65, Figure 81, column 47, line 67 to column 48, line 1, column 49, lines 6-13, column 50, lines 44-60).

Silverbrook fails to explicitly disclose

selecting a family name button when a family name of the remaining customers is a same as that of the representative customer; and

wherein the inputting a family name of the representative customer, as the personal data of the remaining customers, upon selection of said family name button.

However, the above features are well-known in the art, as evidenced by Peterson.

In particular, Peterson teaches a method comprising

selecting a "Customer Group Info icon" (reads on "family name button") (Peterson; Figure 5, Figure 6, Item 3.7.1) when a family name of the remaining customers is a same as that of the representative customer (Peterson; Figure 29, Items 50.1, 50.7, 50.7.1, Figure 9A, column 17, lines 46-58, column 19, lines 1-12, column 24, lines 38-45, column 25, lines 33-35, column 26, lines 42-61, column 40, line 60 to column 41, line 43); and

wherein the inputting a family name of the representative customer, as the personal data of the remaining customers, upon selection of said family name button (Peterson; Figure 29, Items 50.1, 50.7, 50.7.1, Figure 9A, column 17, lines 46-58, column 19, lines 1-12, column 24, lines 38-45, column 25, lines 33-35, column 26, lines 42-61, column 40, line 60 to column 41, line 43); Examiner interprets Peterson's teachings of accessing the "Customer Group Maintenance" procedure by tapping on an icon using an electronic pen in order to modify group information to teach a form of the newly added limitations .

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Silverbrook to include these limitations, as taught by Peterson, with the motivations of providing "a desirable way of transacting insurance matters" at "remote locations from the insurance agent's office" that "is convenient to the customer" while reducing the "potential for errors during entry of the information" (Peterson; column 1, lines 10-25), where "[t]he term "customer" ... [...] ... is not limited to an individual person or policy holder, but rather may encompass numerous individuals or policy holders which are grouped together as a single "customer" because they share a common address, employment or any other characteristic" (Peterson; column 2, lines 35-40).

(B) As per claims 13, 15-22, Silverbrook and Peterson teach a method as analyzed and discussed in claim 11 above

wherein said first registration data is input through a "form" and a "sensing device" (reads on "primary input screen image shown on the display") in the inputting the personal data step (Silverbrook; Figure 81, column 2, lines 45-59); and said second registration data is input

through an “interactive form” (reads on “auxiliary input screen image shown on the screen of the display”) in the inputting at least the name step (Silverbrook; Figure 1, Figure 82, column 8, lines 3-22, column 48, line 1);

further comprising “changing” (reads on “switching”) the “[net]page ID” (reads on “screen images on the screen of the display from said primary input screen image to said auxiliary input screen image”) (Silverbrook; Figure 1, column 20, lines 2-5) in response to the instructions of a “netpage pen” (reads on “screen image switch”) associated with the display (Silverbrook; Figure 1, column 20, lines 2-5); and

wherein the common personal data of said first registration data to be input as part of the personal data of the remaining customers is a family name of the representative customer if the group is a family (Silverbrook; Figure 63, column 9, lines 34-36).

(C) Claims 26, 28, 30-33 differ from method claims 11, 16, 16, 17, 16, 16 respectively by reciting a “computer readable recording medium which records an automated contract engaging program ...” in the preamble.

As per this limitation, Silverbrook clearly discloses “receiving, in a computer system, data from a sensing device” and “interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter” (Silverbrook; column 2, lines 42-59). As such, Silverbrook implicitly includes computer elements such as a computer readable recording medium and a display controller and a contract processor and a contract engaging program. The remainder of claims 26, 28, 30-33 repeat the limitations of claims 11, 16, 16, 17, 16, 16 respectively, and are therefore rejected for the same reasons given above for claims 11, 16, 16, 17, 16, 16, and incorporated herein.

(D) Claims 1, 3, 5-8 differ from method claims 11, 16, 16, 17, 16, 16, respectively by reciting “[a]n automated contract engaging apparatus ...” in the preamble.

Apparatus claims 1, 3, 5-8 repeat the subject matter of claims 11, 16, 16, 17, 16, 16, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 11, 16, 16, 17, 16, 16 have been shown to be obvious in view of the combined teachings of Silverbrook and Peterson in the above rejections of claims 11, 16, 16, 17, 16, 16, it is readily apparent that the system disclosed collectively by Silverbrook and Peterson includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 11, 16, 16, 17, 16, 16, and incorporated herein.

(E) As per newly amended claim 36, Silverbrook teaches a method of engaging a group of customers having common personal data in a single collective contract or a plurality of individual contracts with another party, as analyzed and discussed in the previous office action (paper number 20080212), the method comprising:

deriving registration data which part is common to the group of customers, from registration data of a first customer (Silverbrook; Figure 51, Figure 63, Figure 81, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60);

merging the derived registration data with at least a name inputted for each remaining customers of the group (Silverbrook; Figure 51, Figure 63 to Figure 65, Figure 81 to Figure 84, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60) via an input device common to all customers (Silverbrook; Figure 81, column 8, lines 3-10, 8-20); Examiner interprets Silverbrook’s teachings of interactive input screens or “the netpage system

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relies ... [...] ... human interaction with, netpages. These are pages of text, graphics and images ... [...] ... which work like interactive web pages” (Silverbrook; column 8, lines 4-6) to teach a form of inputting registration data via an input device common to all customers; and

processing and executing the single collective contract or the individual contracts with respect to the group of customers based on the registration data of the first customer and the merged registration data of the remaining customers of the group (Silverbrook; Figure 51, Figure 63 to Figure 65, Figure 81 to Figure 84, column 47, line 66 to column 48, line 2, column 49, lines 6 -13, column 50, lines 44-60).

Silverbrook fails to explicitly disclose

selecting a family name button when a family name of the remaining customer of the group is a same as that of the first customer and inputting the family name of the first customer as personal data of the remaining customers, upon selection of the family name button.

However, the above features are well-known in the art, as evidenced by Peterson.

In particular, Peterson teaches a method comprising

selecting a “Customer Group Info icon” (reads on “family name button”) (Peterson; Figure 5, Figure 6, Item 3.7.1) when a family name of the remaining customer of the group is a same as that of the first customer and inputting the family name of the first customer as personal data of the remaining customers, upon selection of the family name button (Peterson; Figure 29, Items 50.1, 50.7, 50.7.1, Figure 9A, column 17, lines 46-58, column 19, lines 1-12, column 24, lines 38-45, column 25, lines 33-35, column 26, lines 42-61, column 40, line 60 to column 41, line 43); Examiner interprets Peterson’s teachings of accessing the “Customer Group

Maintenance” procedure by tapping on an icon using an electronic pen in order to modify group information to teach a form of the newly added limitation.

The motivations for combining the respective teachings of Silverbrook and Peterson are as given in the rejection of claim 11 above, and incorporated herein.

10. Newly amended claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham et al, U.S. Patent Number 5537315 for substantially the same reasons given in the previous Office Action (paper number 20080212), and further in view of Peterson et al, U.S. Patent Number 5, 903, 873. Further reasons appear hereinbelow.

(A) As per newly amended claim 37, Mitcham teaches a method of engaging a group of customers having common personal data in a single collective contract or a plurality of individual contracts with another party, the method comprising:

creating a group registration data from registration data of a first customer that is common to a group, the registration data of the first customer inputted via a display device (Mitcham; Figure 1, column 3, lines 61-67);

inputting via the same display device the at least name of other members of the group (Mitcham; Figure 13, column 5, lines 9-43, 50-51, column 7, line 54 to column 8, line 10); and

executing the single collective contract or the individual contracts with respect to the group of customers based on the registration data of the first customer and the merged registration data of the remaining customers of the group (Mitcham; Figure 13, Figure 14A, column 4, lines 9-26, column 7, line 54 to column 8, line 10).

Mitcham fails to explicitly disclose

selecting a family name button when a family name of the remaining customers of the group is a same as that of the first customer and inputting the family name of the first customer as personal data of the remaining customers, upon selection of the family name button.

However, the above features are well-known in the art, as evidenced by Peterson.

In particular, Peterson teaches a method comprising

selecting a “Customer Group Info icon” (reads on “family name button”) (Peterson; Figure 5, Figure 6, Item 3.7.1) when a family name of the remaining customer of the group is a same as that of the first customer and inputting the family name of the first customer as personal data of the remaining customers, upon selection of the family name button (Peterson; Figure 29, Items 50.1, 50.7, 50.7.1, Figure 9A, column 17, lines 46-58, column 19, lines 1-12, column 24, lines 38-45, column 25, lines 33-35, column 26, lines 42-61, column 40, line 60 to column 41, line 43); Examiner interprets Peterson’s teachings of accessing the “Customer Group Maintenance” procedure by tapping on an icon using an electronic pen in order to modify group information to teach a form of the newly added limitation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Mitcham to include these limitations, as taught by Peterson, with the motivations of providing “a desirable way of transacting insurance matters” at “remote locations from the insurance agent's office” that “is convenient to the customer” while reducing the “potential for errors during entry of the information” (Peterson; column 1, lines 10-25), where “[t]he term “customer” ... [...] ... is not limited to an individual person or policy holder, but rather may encompass numerous individuals or policy holders which are grouped together as

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a single "customer" because they share a common address, employment or any other characteristic" (Peterson; column 2, lines 35-40).

Response to Arguments

11. Applicant's arguments filed 28 April 2008 regarding pending claims 1, 3, 5-8, 11, 13, 15-22, 26, 28, 30-33, 36-38 have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Lencki et al., 2002/0049617, and Bromley et al., U.S. Patent Number 5, 819, 263, teach the environment of automatically generating contracts.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. A. P./
Examiner, Art Unit 3626
August 14, 2008

/Robert Morgan/
Examiner, Art Unit 3626